

IV. Rejection of Claims 1-3 Under 35 U.S.C. § 101

The Action first rejects claims 1-3 under 35 U.S.C. § 101, as allegedly lacking a patentable utility. Applicants respectfully traverse.

The present invention has a number of substantial and credible utilities, not the least of which is in forensic analysis, as described in the specification, at least at page 3, line 15, and from page 11, line 31 to page 12, line 27. As described in the specification at page 18, lines 3-27, the present sequences define a number of coding single nucleotide polymorphisms - specifically: a C/G polymorphism at position 2361 of SEQ ID NO:1, which can result in an aspartate or glutamate at amino acid position 787 of SEQ ID NO:2; a C/A polymorphism at position 2467 of SEQ ID NO:1, which can result in a leucine or isoleucine at amino acid position 823 of SEQ ID NO:2; a C/A polymorphism at position 2613 of SEQ ID NO:1, both of which result in an isoleucine at corresponding aa position 871 of SEQ ID NO:2; a C/T polymorphism at position 3141 of SEQ ID NO:1, both of which result in a serine at amino acid position 1047 of SEQ ID NO:2; a G/T polymorphism at position 3225 of SEQ ID NO:1, which can result in a glutamine or histidine at amino acid position 1075 of SEQ ID NO:2; a C/T polymorphism at position 3226 of SEQ ID NO:1, which can result in an arginine or tryptophan at amino acid position 1076 of SEQ ID NO:2; and an A/G polymorphism at position 4226 of SEQ ID NO:1, which can result in an aspartate or glycine at amino acid position 1409 of SEQ ID NO:2. As such polymorphisms, and particularly combinations of polymorphisms, are the basis for forensic analysis, which is undoubtedly a “real world” utility, the present sequences must in themselves be useful. It is important to note that the presence of more useful polymorphic markers for forensic analysis would not mean that the present sequences lack utility.

As an additional example of the utility of the present nucleotide sequences, the specification details on page 6, lines 16-18, that the present nucleotide sequences have utility in assessing gene expression patterns using high-throughput DNA chips. Such “DNA chips” clearly have utility, as evidenced by hundreds of issued U.S. Patents, as exemplified by U.S. Patent Nos. 5,445,934, 5,556,752, 5,744,305, 5,837,832, 6,156,501 and 6,261,776. As the present sequences are specific markers of the human genome, and such specific markers are targets for the discovery of drugs that are associated with human disease, those of skill in the art would instantly recognize that the present nucleotide sequences would be an ideal, novel candidate for assessing gene expression using such DNA chips. Clearly, compositions that enhance the utility of such

DNA chips, such as the presently claimed nucleotide sequences, must in themselves be useful.

Although Applicants need only make one credible assertion of utility to meet the requirements of 35 U.S.C. § 101 (*Raytheon v. Roper*, 220 USPQ 592 (Fed. Cir. 1983); *In re Gottlieb*, 140 USPQ 665 (CCPA 1964); *In re Malachowski*, 189 USPQ 432 (CCPA 1976); *Hoffman v. Klaus*, 9 USPQ2d 1657 (Bd. Pat. App. & Inter. 1988)), as a further example of the utility of the presently claimed polynucleotide, as described in the specification at least at page 3, lines 7-10, the present nucleotide sequence has a specific utility in mapping the protein encoding regions of the corresponding human chromosome, specifically chromosome 9. Clearly, the present polynucleotide provides exquisite specificity in localizing the specific region of human chromosome 9 that contains the gene encoding the given polynucleotide, a utility not shared by virtually any other nucleic acid sequences. In fact, it is this specificity that makes this particular sequence so useful. Early gene mapping techniques relied on methods such as Giemsa staining to identify regions of chromosomes. However, such techniques produced genetic maps with a resolution of only 5 to 10 megabases, far too low to be of much help in identifying specific genes involved in disease. The skilled artisan readily appreciates the significant benefit afforded by markers that map a specific locus of the human genome, such as the present nucleic acid sequence.

Additionally, the present invention expands the utility of data coming from the human genome project. Persons of skill in the art, as well as thousands of venture capitalists and investors, readily recognize the utility, both scientific and commercial, of genomic data in general, and specifically human genomic data. All current therapeutics used in humans directly or indirectly interact with biological sequences encoded by the human genome, and virtually all future human therapeutics shall do likewise. Consequently, billions of dollars have been invested in the human genome project, resulting in useful genomic data (see, *e.g.*, Venter *et al.*, 2001, *Science* 291:1304). The results have been a stunning success, as the utility of human genomic data has been widely recognized as a great gift to humanity (see, *e.g.*, Jasny and Kennedy, 2001, *Science* 291:1153). Clearly, the usefulness of human genomic data, such as the presently claimed nucleic acid molecules, is substantial and credible (worthy of billions of dollars and the creation of numerous companies focused on such information) and well-established (the utility of human genomic information has been clearly understood for many years).

Rather, as set forth by the Federal Circuit, “(t)he threshold of utility is not high: An

invention is 'useful' under section 101 if it is capable of providing some identifiable benefit." *Juicy Whip Inc. v. Orange Bang Inc.*, 51 USPQ2d 1700 (Fed. Cir. 1999) (citing *Brenner v. Manson*, 383 U.S. 519, 534 (1966)). Additionally, the Federal Circuit has stated that "(t)o violate § 101 the claimed device must be totally incapable of achieving a useful result." *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992), emphasis added. *Cross v. Iizuka* (224 USPQ 739 (Fed. Cir. 1985); "*Cross*") states "any utility of the claimed compounds is sufficient to satisfy 35 U.S.C. § 101". *Cross* at 748, emphasis added. Indeed, the Federal Circuit recently emphatically confirmed that "anything under the sun that is made by man" is patentable (*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998), citing the U.S. Supreme Court's decision in *Diamond vs. Chakrabarty*, 206 USPQ 193 (S.Ct. 1980)).

In *In re Brana*, (34 USPQ2d 1436 (Fed. Cir. 1995), "*Brana*"), the Federal Circuit admonished the P.T.O. for confusing "the requirements under the law for obtaining a patent with the requirements for obtaining government approval to market a particular drug for human consumption". *Brana* at 1442. The Federal Circuit went on to state:

At issue in this case is an important question of the legal constraints on patent office examination practice and policy. The question is, with regard to pharmaceutical inventions, what must the applicant provide regarding the practical utility or usefulness of the invention for which patent protection is sought. This is not a new issue; it is one which we would have thought had been settled by case law years ago.

Brana at 1439, emphasis added. The choice of the phrase "utility or usefulness" in the foregoing quotation is highly pertinent. The Federal Circuit is evidently using "utility" to refer to rejections under 35 U.S.C. § 101, and is using "usefulness" to refer to rejections under 35 U.S.C. § 112, first paragraph. This is made evident in the continuing text in *Brana*, which explains the correlation between 35 U.S.C. §§ 101 and 112, first paragraph. The Federal Circuit concluded:

FDA approval, however, is not a prerequisite for finding a compound useful within the meaning of the patent laws. Usefulness in patent law, and in particular in the context of pharmaceutical inventions, necessarily includes the expectation of further research and development. The stage at which an invention in this field becomes useful is well before it is ready to be administered to humans. Were we to require Phase II testing in order to prove utility, the associated costs would prevent many companies from obtaining patent protection on promising new inventions, thereby eliminating an incentive to pursue, through research and

development, potential cures in many crucial areas such as the treatment of cancer.

Brana at 1442-1443, citations omitted. Even if, *arguendo*, further research might be required in certain aspects of the present invention, this does not preclude a finding that the invention has utility, as set forth by the Federal Circuit's holding in *Brana*, which clearly states, as highlighted in the quote above, that "pharmaceutical inventions, necessarily includes the expectation of further research and development" (*Brana* at 1442-1443, emphasis added). In assessing the question of whether undue experimentation would be required in order to practice the claimed invention, the key term is "undue", not "experimentation". *In re Angstadt and Griffin*, 190 USPQ 214 (CCPA 1976). The need for some experimentation does not render the claimed invention unpatentable. Indeed, a considerable amount of experimentation may be permissible if such experimentation is routinely practiced in the art. *In re Angstadt and Griffin, supra; Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 18 USPQ2d 1016 (Fed. Cir. 1991). As a matter of law, it is well settled that a patent need not disclose what is well known in the art. *In re Wands*, 8 USPQ 2d 1400 (Fed. Cir. 1988).

The Action states that the invention lacks utility because the disclosure does not provide a "demonstrated function for the protein of SEQ ID NO:2" (Action at page 2, emphasis added). This argument fails, because it has long been established that "there is no statutory requirement for the disclosure of a specific example". *In re Gay*, 135 USPQ 311 (CCPA 1962).

Finally, the requirements set forth in the Action for compliance with 35 U.S.C. § 101 do not comply with the requirements set forth by the Patent and Trademark Office ("the PTO") itself for compliance with 35 U.S.C. § 101. The PTO has issued numerous patents on polynucleotide sequences that have not been directly shown to be associated with the function of the protein that is set forth in the specification, the condition apparently set forth by the Examiner as allegedly necessary to comply with 35 U.S.C. § 101. The Examiner is invited to review U.S. Patent Nos. 5,817,479, 5,654,173, and 5,552,2812 (each of which claims short polynucleotide fragments), and recently issued U.S. Patent No. 6,340,583 (which includes no working examples). None of these issued U.S. Patents contain examples of the "real-world" utilities that the Examiner seems to be requiring in the present Action. As issued U.S. Patents are presumed to meet all of the requirements for patentability, including 35 U.S.C. §§ 101 and 112, first paragraph (see Section V below), Applicants submit that the presently claimed polynucleotide must also meet the

requirements of 35 U.S.C. § 101. Holding Applicants to a different standard of utility would be arbitrary and capricious, and cannot stand.

For each of the foregoing reasons, Applicants submit that as the presently claimed nucleic acid molecules have been shown to have a substantial, specific, credible and well-established utility, the rejection of claims 1-3 under 35 U.S.C. § 101 has been overcome, and request that the rejection be withdrawn.

V. Rejection of Claims 1-3 Under 35 U.S.C. § 112, First Paragraph

The Action next rejects claims 1-3 under 35 U.S.C. § 112, first paragraph, since allegedly one skilled in the art would not know how to use the invention, as the invention allegedly is not supported by a specific, substantial, and credible utility or a well-established utility. Applicants respectfully traverse.

Applicants submit that as claims 1-3 have been shown to have “a specific, substantial, and credible utility”, as detailed in section IV above, the present rejection of claims 1-3 under 35 U.S.C. § 112, first paragraph, cannot stand.

Applicants therefore request that the rejection of claims 1-3 under 35 U.S.C. § 112, first paragraph, be withdrawn.

VI. Conclusion

The present document is a full and complete response to the Action. In conclusion, Applicants submit that, in light of the foregoing remarks, the present case is in condition for allowance, and such favorable action is respectfully requested. Should Examiner Swope have any questions or comments, or believe that certain amendments of the claims might serve to improve their clarity, a telephone call to the undersigned Applicants' representative is earnestly solicited.

Respectfully submitted,

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Exhibit B

Marked Up Version of Amended Claims in U.S. Patent Application Ser. No. 10/044,807

1. An isolated nucleic acid molecule comprising the nucleotide sequence of SEQ ID NO:1.
2. An isolated nucleic acid molecule comprising a nucleotide sequence that encodes the amino acid sequence shown in SEQ ID NO:2.
3. An isolated expression vector comprising the nucleotide sequence of SEQ ID NO:1.
4. (New) A host cell comprising the expression vector of claim 3.

Exhibit C

Marked Up Version of Amended Title in U.S. Patent Application Ser. No. 10/044,807

[Novel] Human Protease [and] Polynucleotides [Encoding] and Compositions
Comprising the Same